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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/813,980

03/31/2004

Edward Wells Knowlton

KNW-0018

5920

77845

7590

12/09/2009

Goodwin Procter LLP

Attn: Patent Administrator

135 Commonwealth Drive

Menlo Park, CA 94025-1105

EXAMINER

SWEET, THOMAS

ART UNIT

PAPER NUMBER

3774

MAIL DATE

DELIVERY MODE

12/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/813,980	<b>Applicant(s)</b> KNOWLTON, EDWARD WELLS	
	<b>Examiner</b> Thomas J. Sweet	<b>Art Unit</b> 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08/17/2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 15-24 and 26-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 15-24 and 26-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Response to Arguments***

Applicant's arguments filed 08/17/2009, with respect to the drawing have been fully considered and are persuasive. The objection of drawings has been withdrawn.

Applicant's arguments, see pages 10-16, filed 08/17/2009, with respect to the rejection(s) of claim(s) 1-42 under 35 USC 120 and 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Bender 1,023,358.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 43 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. The limitation "known in the art" is indefinite and a omnibus limitation. Additonally, the limitation "by hand" is non-statutory so it can be part of the method but has no enforceable limitation since the manual actions of a person can not legally be controlled. (i.e. the step reading on a manual step can not be a point of patentability, eventhough its necessary for the method, so this limitation can not be the only thing defining the current invention over the prior art). The examiner suggests positively claiming (in all claims ) another of the pre-positioning method to the exclusion of "by hand".

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 15-24, 26-29, 31-40 and 42-43 are rejected under 35 U.S.C. 103(a) as obvious over Knowlton (US 6,350,276) in view of Dressel (US 4985027) and Bender (US 1,023,358). Knowlton discloses a method of energetically treating a target tissue site (col 11-12, thermal), the method comprising: pre-positioning tissue in a aesthetically (background on the invention, such as line 40-42 and inherent positioning of the patient for access) correct configuration (cols 19-20, lines 62-3, contact and pressure are required otherwise there is no current flow) wherein pre-positioning of the selected tissues (via inherent surgical positioning to access and work on the cite, disclosed liposuction a pretreatment including positioning, the conforming template which is prepositions prior to energetically treating and the template “can be separate” therefore per-positioned “with the energy delivery device”, col 13, lines 48-50) is used to shape a thermal lesion so as to create or facilitate the creation of a directed wound healing response (i.e. the lesion is formed on moved tissue);

delivering energy to the tissue site using an energy delivery device (col 12, lines 5-11);  
delivering a vectored mechanical force to the tissue site (col 12, lines 5-11);

producing a thermal adhesion or lesion at the tissue site (i.e. cleave of collagen crosslinks); and

remodeling at least a portion of tissue at the tissue site (to achieve a smoother contour).

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However, Knowlton does not specify that the pre-positioning is to reduce skin tension of the treatment site.

Bender teaches another aesthetic pre-positioning is to reduce skin tension of the treatment site for the purpose of removing defects (col 1 line 10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the pre-positioning as taught by Bender as part of the pre-positioning of Knowlton in order to remove defects. The combination amounts to mere substitution of one pre-positioning step for part of another within the art of removing skin defects.

With regard to claims 2 and 3, inherently a patient is pre-positioned for treatment (e.g. a patient is placed on an operating table, standing, etc...) in conjunction with the treatment as well as the additional bender teaching.

With regard to claims 22, 33, 37 and 39, selecting the tissue site based on an amount of convexity at the tissue site (inherent to smooth the contour).

With regard to claims 4-7, 31, 35-36, 38 and 40-42, producing a plurality of adhesions or lesions is substantially continuous or at least partially overlapping and delivering energy in a selected pattern (Col 6, lines 5-48, discontinuous modes/pattern of application, specifically lines 22-23 states power is pulsed which is overlapping and a pattern).

With regard to claim 8, the force is a substantially uniform force applied over the tissue site (col 12, line 17).

With regard to claims 9-10, force profile with respect to a radial direction of a force application surface, the force profile substantially increasing in an inward direction with respect to an edge of the force application surface (col 17, lines 8-22- the tissue interface inherently

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applies this force profile by having radiused edges and as described in the paragraph from col 18-19)

With regard to claim 11, delivering a first force in a first direction and delivering a second force in a second direction (col 12, lines 17-24).

With regard to claim 14, pre-positioning tissue at the tissue site substantially prior to energy delivery to shape the tissue adhesion or lesion or create a directed wound healing response (the disclosed bipolar RF energy system requires contact with the skin to work and the tensioning device 16 is separate from the electrodes 18 which pre-contact the tissue as the electrode are brought into contact with the tissue).

With regard to claims 15-16, 19, 34 and 38, cooling a layer of tissue or a surface layer of tissue of at least a portion of the tissue site (col 4, lines 7-9) and producing a reverse thermal gradient within at least a portion of the tissue site (col 5, lines 52-59) which preserves at least a portion of a surface, a tissue layer or an epidermal layer at or adjacent the tissue site.

With regard to claims 27 and 29, performing a liposuction procedure substantially at the tissue site (col 1-2, lines 54-16).

With regard to claim 28, skeletonizing at least a portion of fibrous septae at the tissue site (an unintended side effect as discussed in Col 12 lines 34-49).

With regard to claim 43, lipo is disclosed by Knowlton as previously rejected

Claims 30 and 41 are rejected under Knowlton (US 6,350,276) in view of Dressel (US 4985027) and Bender (US 1,023,358). Knowlton discloses a method of energetically treating a target tissue as rejected above.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Sweet whose telephone number is 571-272-4761. The examiner can normally be reached on 6:45am - 5:15pm, Tu-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas J Sweet/

Primary Examiner, Art Unit 3774